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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER
HUTTON JR, WILLIAM D

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 07/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>22 April 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
    closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-5,8-14 and 17-24</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-5,8-14 and 17-24</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>07 March 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

    1.☐ Certified copies of the priority documents have been received.

    2.☐ Certified copies of the priority documents have been received in Application No. _____.

    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
        application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

Applicant's Response

In Applicant's Response dated 22 April 2005, Applicant filed a Request for

Continued Examination, submitted a Declaration under 37 C.F.R. §1.131, and argued

against all rejections previously set forth in the Office Action dated 11 January 2005.

Specification

The specification is objected to as failing to provide proper antecedent basis for

the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction

of the following is required:

- the Specification fails to mention the "computer-readable medium" recited in

  Claim 20 (see Line 2); and

- the Specification fails to mention "converting said markup language file into

  another markup language file," as recited in Claim 24, Lines 1-2 (The examiner

  interprets Claim 23 as specifying that an HTML file is generated based on the

  mapping between the elements file and a style template (see Claim 23, Lines 7-

  8). In other words, the "markup language file" mentioned in Claim 23, Line 7 is

  the "second markup language file" that results from a conversion of a "first

  markup language file," as recited in Claim 1, Lines 9-12. Thus, under the

  examiner's interpretation, the "another markup language file" recited in Claim 24,

  Line 2 is a "third markup language file." The Specification of the present

  invention does not mention converting the "second markup language file" to a

"third markup language file." For purposes of writing a rejection for Claim 24, the

examiner will assume that the "another markup language file" in Line 2 is no

different than the "markup language file" recited in Claim 23, Line 7.).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5, 8-14, 19, 21 and 22 are rejected under 35 U.S.C. 101 because the

claimed invention is directed to non-statutory subject matter.

Claims 1-5, 8, 9, 21 and 22:

The language of the claims raise a question as to whether the claims are directed

merely to an abstract idea that is not tied to a technological art, environment or machine

which would result in a practical application producing a concrete, useful, and tangible

result to form the basis of statutory subject matter under 35 U.S.C. 101.

Claim 1 recites "[a]n apparatus . . . comprising:" a "first logic" and a "second

logic" (see Claim 1, Lines 1, 2 and 9). Although the preamble identifies the invention as

an "apparatus," the recited elements of the invention clearly indicate that it is a

computer program. Because the claim fails to recite that the software is embodied on

a tangible computer-readable medium, the invention is neither concrete nor tangible, as

currently recited.

Additionally, as currently recited in Claim 1, the invention is functional descriptive material because it comprises merely a method of manipulating data. Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760. Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized.

Claim 21 has the same problems mentioned in the above discussion for Claim 1.

Claims 2-5, 8 and 9 are also rejected because these claims are dependent upon Claim 1 and recite no limitations that make the invention concrete and tangible.

Claim 22 is also rejected because this claim is dependent upon Claim 21 and recites no limitations that make the invention concrete and tangible.

Applicant may obviate this rejection by amending the preambles of Claims 1 and 21 to read: — A computer program tangibly embodied on a computer-readable medium, comprising: —.

The claim recites a method for "inserting formatting commands into textual information."

Claims 10-14, 17 and 19:

The subject matter specified in the claims is non-statutory and fails to recite patent-eligible subject matter in that it is not in the useful or technological arts.

Additionally, the claimed invention is so abstract and sweeping that it covers the method as practiced by a human operator assisted only by pencil and paper. The claims do not include a particular machine or apparatus, and no machine-implemented steps are recited. Every step is capable of performance by the human mind. A method of this sort, traditionally called a "mental process," is not patentable subject matter.

"Phenomena of nature, though just discovered, "*mental processes*," abstract intellectual concepts are not patentable as they are the basic tools of scientific and technological work." (emphasis added) *Gottschalk v. Benson*, 75 U.S.P.Q. 673, 675 (U.S.S.C. 1972). See also, *In re Prater and Wei*, 159 U.S.P.Q. 583 (1968), *rehearing* U.S.P.Q. 571 (1969).

Applicant may obviate this rejection by amending the preamble of Claim 10 to read: — A computerized method for generating files, the method comprising: —.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 8-14 and 17-24 are rejected under 35 U.S.C. 102(b) as being anticipated by http://web.archive.org/web/19991111161335/http://www.scriptorium.com/index.html (hereinafter, Scriptorium), as it appeared on 1 March 2000.

Claim 1:

Scriptorium discloses an apparatus for generating files (see Pages 1-14 of 14),

the apparatus comprising:

- a first logic configured to perform a technical writing tool algorithm (see Page 2 of

  14 – Scriptorium discloses this limitation in that it teaches FrameMaker), the

  technical writing tool algorithm for receiving input describing a particular selected

  format and content for a document (Scriptorium discloses this limitation in that

  FrameMaker allows the user to specify a structure for a document and flow the

  content into the document structure), the technical writing tool algorithm for

  processing said input to generate a first markup language file based on an

  elements file (Scriptorium discloses this limitation in that FrameMaker creates an

  output document in SGML format, which is based on the document structure

  developed by the user. The "structure" developed by the user is defined in an

  Element Definition Document.), said elements file defining elements included in

  said first markup language file and a structure for each of said elements

  (Scriptorium discloses this limitation in that FrameMaker allows the user to

  develop the document structure), wherein said first markup language file is

  printable as a hardcopy document (Scriptorium discloses this limitation in that

  FrameMaker is used to print hardcopy documents), said first markup language

  file including first markup language formatting information (Scriptorium discloses

  this limitation in that FrameMaker outputs documents in SGML format); and

- a second logic configured to receive the first markup language file and to perform a conversion algorithm that converts the first markup language file into a second markup language file based on at least one of a plurality of style templates that are external to said elements file (see Pages 2 and 4-5 of 14 – Scriptorium discloses this limitation in that it teaches WebWorks Publisher, which is a conversion tool that is used to convert FrameMaker files to HTML. That is, WebWorks Publisher may be used to convert SGML documents to HTML documents. WebWorks Publisher includes a plurality of style templates that may be customized by the user. These style templates are "external" to the Element Definition Document in that the style templates are in the WebWorks Publisher software and the Element Definition Document is in the FrameMaker software.), said at least one style template mapped to at least one of said elements and defining a style for said at least one element (see Page 12 of 14 – Scriptorium discloses this limitation in that WebWorks Publisher allows FrameMaker+SGML users to map elements instead of mapping tags. That is, users may map FrameMaker elements to WebWorks Publisher styles.), wherein said second markup language file includes a second markup language formatting information describing a particular on-line format and content of said document (see Page 2 of 14 – Scriptorium discloses this limitation in that WebWorks Publisher converts the FrameMaker documents into HTML documents for publishing online content).

Claim 2:

Scriptorium discloses the apparatus of Claim 1, wherein said input describing said particular format includes style information that describes a style that document elements are to have if the first markup language file is printed (Scriptorium discloses this limitation in that FrameMaker allows the user to specify the document structure in the Element Definition Document. The Element Definition Document may be used to output a document in SGML format.).

Claim 3:

Scriptorium discloses the apparatus of Claim 1, wherein said input describing said particular format includes style information that describes a style that document elements are to have if the second markup language file is placed on-line (Scriptorium discloses this limitation in that WebWorks Publisher converts the FrameMaker document into an HTML document that has "style information" that instructs a computer how to present the HTML document online).

Claim 4:

Scriptorium discloses the apparatus of Claim 1, wherein said first markup language is a Standard Generalized Markup Language (as specified in the above rejection for Claim 1, the first markup language is SGML).

Claim 5:

Scriptorium discloses the apparatus of Claim 1, wherein said second markup language is a Hypertext Markup Language (as specified in the above rejection for Claim 1, the second markup language is HTML).

Claim 8:

Scriptorium discloses the apparatus of Claim 1, wherein said first markup language is a Standard Generalized Markup Language and wherein said second markup language is a Hypertext Markup Language (as specified in the above rejection for Claim 1, the first markup language is SGML and the second markup language is HTML).

Claim 9:

Scriptorium discloses the apparatus of Claim 8, wherein said first logic is pre-configured to map styles native to said technical writing tool algorithm to styles native to said conversion algorithm (Scriptorium discloses this limitation in that WebWorks Publisher allows the user to map FrameMaker elements to WebWorks Publisher styles), and wherein said first markup language formatting information includes information relating to said styles native to said conversion algorithm (Scriptorium discloses this limitation in that WebWorks Publisher allows the user to map FrameMaker elements to WebWorks Publisher styles. That is, the user may map SGML elements in the Element Definition Document to WebWorks Publisher styles.).

Claims 10-14 and 17:

Claims 10-14 and 17 merely recite the method performed by the apparatus of

Claims 1-5 and 8, respectively. Thus, Scriptorium discloses every limitation of Claims

10-14 and 17, as indicated in the above rejections for Claims 1-5 and 8.

Claim 18:

Scriptorium discloses the method of Claim 10, wherein the processing is

performed by a technical writing tool software program being executed on a computer

(Scriptorium discloses this limitation in that it teaches FrameMaker), wherein the

converting is performed by conversion software program being executed on a computer

(Scriptorium discloses this limitation in that it teaches WebWorks Publisher), and

wherein said method further comprises:

- mapping, prior to processing, styles native to said technical writing tool algorithm

  to styles native to said conversion algorithm, and wherein said first markup

  language formatting information includes information relating to said styles native

  to said conversion algorithm (Scriptorium discloses these limitations in that

  WebWorks Publisher allows the user to save style mappings and style templates

  for reuse so users do not have to reapply the same customization with every

  use).

Claim 19:

Scriptorium discloses the method of Claim 18, wherein said first markup language is a Standard Generalized Markup Language and wherein said second markup language is a Hypertext Markup Language (as specified in the above rejection for Claim 1, the first markup language is SGML and the second markup language is HTML).

Claim 20:

Claim 20 merely recites computer software that performs the same method performed by the apparatus of Claim 1. Thus, Scriptorium discloses every limitation of Claim 20, as indicated in the above rejection for Claim 1.

Claims 21 and 22:

Claims 21 and 22 merely recite limitations included in Claim 1. Thus, Scriptorium discloses every limitation of Claims 21 and 23, as indicated in the above rejection for Claim 1.

Claim 23:

Scriptorium discloses a method for generating files (see Pages 1-14 of 14), comprising:

- storing an elements file defining markup language file elements and a structure for each of said elements (Scriptorium discloses this limitation in that

FrameMaker allows the user to create and store the Element Definition

Document);

- maintaining a plurality of style templates separate from said elements

(Scriptorium discloses this limitation in that FrameMaker includes style templates

that may be customized by the user. These style templates are "separate" from

the Element Definition Document in that the style templates are in the WebWorks

Publisher software and the Element Definition Document is in the FrameMaker

software), each of said style templates mapped to at least a respective one of

said elements and defining a style for said one element (Scriptorium discloses

this limitation in that WebWorks Publisher allows users to map FrameMaker

elements to WebWorks Publisher styles);

- generating a markup language file based on said elements file and at least one

of said style templates that is mapped to at least one of said elements included in

said markup language file (Scriptorium discloses this limitation in that WebWorks

Publisher converts FrameMaker files to HTML files based on the mapping

between the FrameMaker elements and the WebWorks Publisher styles), said

markup language file having formatting information based on said at least one

style template (Scriptorium discloses this limitation in that the HTML document,

created by converting the FrameMaker document, is based on the mapping

between the FrameMaker elements and the WebWorks Publisher styles); and

- displaying an image of a document defined by said markup language file

  (Scriptorium discloses this limitation in that the HTML document is displayed

  online).

Claim 24:

Scriptorium discloses the method of Claim 23, further comprising converting said

markup language file into another markup language file having formatting information

that is based on at least one of said style templates (Scriptorium discloses this limitation

in that WebWorks Publisher converts SGML files to HTML files).

Response to Arguments

Applicant's arguments with respect to Claims 1-5, 8-14 and 17-24 have been

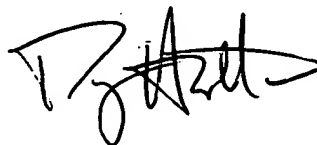considered but are moot in view of the new grounds of rejection.

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Doug Hutton whose telephone number is (571) 272-
4137. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00
PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Heather Herndon, can be reached at (571) 272-4136. The fax phone
number for the organization where this application or proceeding is assigned is (703)
872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

WDH
July 6, 2005

DOUG HUTTON
PATENT EXAMINER
TECH CENTER 2100